

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks.

Claims 11-16, 25, and 26 are pending in the application. Claims 1-3, 6, 8-10, 17-21, 23, and 24 are canceled herein without prejudice to or disclaimer of the subject matter recited therein. Claims 11 and 16 are amended, and claims 25 and 26 are newly added. Support for the claim amendments and additions can be found in the original specification at least at paragraphs [0020], [0027], and [0028], and FIGS. 8-11. No new matter has been added.

Specification Objection

In the Office Action, the specification was objected to because "it does not describe how the engagement portion is removeably attached to the body portion of the cutting guide." This objection is respectfully traversed.

37 C.F.R. § 1.71 (a) provides that:

The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(Emphasis added.)

In this case, the original specification describes at paragraph [0004] that the "engagement portion [is] concentrically attached to the body portion." The specification also describes at paragraph [0020] that "[t]he body portion may be constructed of a durable material such as, for example, metal or plastic" and that "[t]he engagement portion 14 is constructed of a non-slip, or tacky, material such as, for example, rubber or plastic." Still further, at paragraph [0033] the

specification describes that “[i]n various embodiments, the engagement portion 14 is removable from the body portion 12, 30 so that the engagement portion may be replaced if it becomes worn, damaged, etc.”

There are numerous ways in which the engagement portion of the cutting guide may be removably attached to the body portion, many of which would be readily apparent to one of ordinary skill in the art from Applicant’s disclosure. For example, the engagement portion could simply slip concentrically over the body portion and be held in place by the friction between the engagement portion and the body portion, the engagement portion could fit in a groove in the exterior of the body portion, or the engagement portion could be removably attached to the body in numerous other ways. From the specification, one of ordinary skill in the art would readily be able to make and use a cutting guide having an engagement portion removably attached to a body portion, without undue experimentation.

Drawing Objection

The drawings were objected to under 37 C.F.R. § 1.83(a), because the “removable engagement portion” of claim 24 is allegedly not shown in the drawings. This objection is respectfully traversed. While claim 24 has been canceled, the features of that claim have been incorporated into independent claim 11.

As noted in the Office Action, § 1.83(a) requires that the “drawing in a nonprovisional application must show every feature of the invention specified in the claims.” However, there is no requirement that the drawings show an element in multiple different conditions (e.g., attached and removed). In this case, the engagement portion 14 is shown in FIGS. 1-7 and 11 attached to the body portion 12. The specification describes, at paragraph [0033] that “[i]n various

embodiments, the engagement portion 14 is removable from the body portion 12, 30 so that the engagement portion may be replaced if it becomes worn, damaged, etc.” Claim 24 does not recite that the engagement portion is actually removed from the body portion, merely removable. Thus, Applicant submits that the “removable engagement portion” of claim 24 is adequately illustrated in the drawings.

§ 112 First Paragraph Rejection

Claim 24 was rejected under 35 U.S.C. § 112, first paragraph, as “failing to comply with the written description requirement” because “it is unclear how the engagement portion is removably attached to the body portion of the cutting guide.” This rejection is respectfully traversed. While claim 24 has been canceled, the features of that claim have been incorporated into independent claim 11.

34 U.S.C. § 112, first paragraph, states that:

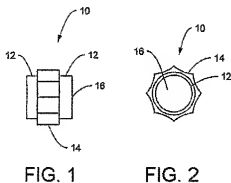
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

As noted above, the written description clearly describes that the “engagement portion [is] concentrically attached to the body portion” (at paragraph [0004]), “[t]he body portion may be constructed of a durable material such as, for example, metal or plastic” and “[t]he engagement portion 14 is constructed of a non-slip, or tacky, material such as, for example, rubber or plastic” (at paragraph [0020]), and “[i]n various embodiments, the engagement portion

14 is removable from the body portion 12, 30 so that the engagement portion may be replaced if it becomes worn, damaged, etc.” (at paragraph [0033]).

The Office Action also states that “the engagement portion and the body portion appear to be a one-piece part but not two separate parts” Applicants disagree that the figures show a one-piece part but not two separate parts.

The engagement portion 14 is shown in FIGS. 1-7 and 11 attached to the body portion 12. FIGS. 1 and 2 are reproduced below.



In Applicant’s view, the drawings equally show that the engagement portion 14 and body portion 12 could be two separate parts that are merely assembled together (or “removably attached”), as shown in FIGS. 1 and 2 above.

The foregoing description and drawings make clear that Applicant was in possession of the claimed subject matter at the time the application was filed, and would enable one of ordinary skill in the art to make and use the claimed saw without undue experimentation.

For at least the foregoing reasons, Applicant submits that the application, including the drawings, as originally filed, complies with all aspects of § 112, first paragraph.

Art Rejections

Claims 11-16 and 24 were rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 1,395,957 (Griffin) in view of U.S. Patent No. 6,944,961 B2 (Carroll). This rejection is respectfully traversed. Nevertheless, claim 24 has been canceled rendering the rejection of that claim moot, and claim 11 has been amended to incorporate the features of dependent claim 24.

Independent Claim 11, as presently presented, is directed to a saw comprising, among other things, a cutting guide held by the cutting guide holder. The cutting guide comprises a body portion and an engagement portion, with a groove disposed in an outer surface of the body portion on the leading or trailing edge of the body portion. The groove is configured to fit in the cutting guide holder attached to the saw. The engagement portion is constructed of one of rubber and plastic, and is removably attached to the body portion. The body portion is cylindrical and is constructed of a hardened metal.

Griffin fails to disclose or suggest such features. Griffin discloses a handsaw that can be used as a square and that has a pencil holder. The pencil holder includes a U-shaped member secured at each end to the saw handle, and a spring having downwardly bowed portions and outwardly curved extremities (Griffin, ln. 52-61). However, Griffin fails to disclose a saw having a cutting guide held by the cutting guide holder, the cutting guide comprising "a groove disposed in an outer surface of a body portion on the leading or trailing edge of the body portion, the groove being configured to fit in the cutting guide holder attached to a saw," as presently recited in independent claim 11. Griffin also fails to disclose or suggest a cutting guide having an engagement portion "constructed of one of rubber and plastic, and removably attached to the body portion," as also recited in independent claim 11. Still further, Griffin fails to disclose or

suggest a cutting guide having a body portion that is “cylindrical and is constructed of a hardened metal,” as also recited in independent claim 11.

Carroll was cited for its teaching of a cutting guide, as shown in FIG. 1 of that patent (reproduced below).

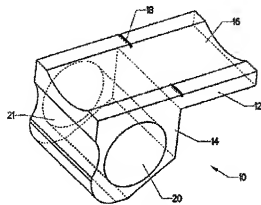


FIG. 1

However, Carroll fails to remedy the deficiencies in Griffin noted above with respect to independent claim 11, assuming for the sake of argument that the documents can even be combined. For example, Carroll fails to teach or suggest at least the following features of independent claim 11:

- a cutting guide comprising “a groove disposed in an outer surface of a body portion on the leading or trailing edge of the body portion, the groove being configured to fit in the cutting guide holder attached to a saw,”
- a cutting guide having an engagement portion “constructed of one of rubber and plastic, and removably attached to the body portion,” and
- a cutting guide having a body portion that is “cylindrical and is constructed of a hardened metal”.

For at least the foregoing reasons, independent claim 11 is patentable over Griffin in view of Carroll, even if, for the sake of argument, the documents could be combined as suggested in the Office Action.

Furthermore, one of ordinary skill in the art would not have been motivated to combine the cited documents. In fact, the Office Action has not provided any motivation to combine the cited documents, merely stating that "it would have been obvious to one skilled in the art to incorporate the Carroll's cutting guide into the Griffin's saw for guiding the saw." Accordingly, Applicant submits that the Office has not met its burden of providing a *prima facie* case of obviousness. For at least this additional reason, Applicants request withdrawal of the rejections based on Griffin in view of Carroll.

Dependent claims 12-16 depend from independent claim 11 and are allowable by virtue of this dependency, as well as for additional features that they recite.

New independent claims 25 and 26 recite additional features which are neither disclosed nor suggested by the cited documents. For example, **claim 25** recites "wherein the engagement portion is constructed of one of rubber and plastic, and the body portion is cylindrical and is constructed of a hardened metal." As discussed above with respect to claim 24, neither Griffin nor Carroll teaches a cutting guide having an engagement portion "constructed of one of rubber and plastic" and a body portion that is "cylindrical and is constructed of a hardened metal," as presently recited in independent claim 25.

Claim 26 is directed to a saw comprising, among other things, "a cutting guide holder disposed on a lateral side of the handle; and a cutting guide held by the cutting guide holder so that the cutting guide is retained on a lateral side of the handle of the saw. Neither Griffin nor Carroll teaches or suggests such features.

Accordingly, new claims 25 and 26 are believed to be allowable for at least these reasons.

Conclusion

For at least the foregoing reasons, claims 11-16, 25, and 26 are in condition for allowance. Applicants respectfully request reconsideration and withdrawal of the objections and rejections, and issuance of a notice of allowance.

If any issue remains unresolved that would prevent allowance of this case, **the Examiner is requested to contact the undersigned attorney to resolve the issue.**

Respectfully submitted,

Date: September 5, 2006

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